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Group Art Unit: 2859

REMARKS/ARGUMENTS

Claims 1-68 were pending in the application as filed. By a previous amendment, claims 57 and 58 were cancelled, and claims 69-72 were added. In this Office action, claims 37-39, 44, 49, and 53-56 stand rejected under 35 U.S.C. §102(e). Claims 40-43, 45-48, and 50-52 stand objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-36, and 59-72 stand allowed. Applicant appreciates the Examiner's early notification of allowable subject matter.

Reconsideration and reexamination of the application is respectfully requested in view of the following remarks.

Rejection Under 35 U.S.C. §102(e)

Claims 37-39, 44, 49, and 53-56 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,594,922 to Mansfield et al. The rejection is respectfully traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 37

Claim 37 describes a corrective alignment insole assembly for making a shoe correction for the alignment of a person's foot. The assembly comprises a base insole, at least one supination control pad, at least one pronation control pad, and at least one arch control pad. The base insole is adapted for correcting both pronation and supination in combination with at least one of the supination control pad, pronation control pad, or arch control pad. The supination control pad, pronation control pad, and arch control pad are selected based upon a lateral angular alignment measurement of the person's foot.

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Mansfield '922 discloses a stabilizer 2 comprising "a single, one piece unit," *Mansfield '922, col. 6, ln. 43-44*, having "a tear-dropped convex mound 12...positioned proximal to the metatarsal head areas and adjacent the metatarsal arch of the foot," *Id., col. 6, ln. 26-28*, "a rounded surface 20...positioned immediately adjacent to the lateral arch of the foot." *Id., col. 6, ln. 64-65*, and "a rounded surface 18...positioned immediately adjacent to the medial arch of the foot." *Id., col. 6, ln. 56-58*. Mansfield '922 does not disclose selecting a supination control pad, pronation control pad, or arch control pad based upon a lateral angular alignment measurement of the person's foot.

Claim 37 is not anticipated by Mansfield '922. Claim 37 requires that the supination control pad, pronation control pad, and arch control pad be selected based upon a lateral angular alignment measurement of the person's foot. Mansfield '922 discloses no such measurement. Indeed, Mansfield '922 contemplates that the stabilizer described therein will be "mass produced" and based upon "preset sizes based upon the average contours for premeasured feet." *Mansfield '922, col. 9, ln. 57-58*. In the only reference to a "custom" fit, Mansfield '922 describes preparing a stabilizer by making a mold of a person's foot. No measurements are described, let alone a lateral angular alignment measurement. *Id., col. 10, ln. 26-30*.

Moreover, the stabilizer in Mansfield '922 comprises a single piece. Claim 37, however, describes a multi-piece insole assembly. The supination control pad, pronation control pad, and arch control pad are attached to the base insole in a built-up assembly tailored to an individual's unique carriage. The number, dimensions, and placement of the pads are established by the lateral angular alignment measurement of the person's foot. In contrast, the convex mound 12, rounded surface 20, and rounded surface 18 are integrally molded into the stabilizer to form a single, unitary piece. This is not the multi-piece insole assembly described in claim 37.

Claim 37 is not anticipated by Mansfield '922 under 35 U.S.C. §102(e) since "each and every element of the claimed invention" of claim 37 is not found in Mansfield '922, *Hybritech, Inc., supra*. Thus, claim 37 is in condition for immediate allowance. Applicant requests that the

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rejection of claim 37 be withdrawn, and that claim 37 be allowed.

Because claims 38-39, 44, 49, and 53-56 depend from claim 37, they are similarly not anticipated by Mansfield '922. Nevertheless, claims 38-39, 44, 49, and 54-56 are not anticipated by Mansfield '922 for the following additional reasons.

Claim 38

Mansfield '922 does not disclose the base insole being divided into an irregularly-shaped supination control portion, an irregularly-shaped motion control portion, and a crescent-shaped arch stability portion, as described in claim 38. In arguing that claim 38 is anticipated by Mansfield '922, the Examiner simply asserts that Mansfield '922 discloses these elements of claim 38, and references Figures 1 and 2. The Examiner does not even attempt to identify those structural elements in Figures 1 and 2 corresponding to the supination control portion and the motion control portion described in claim 38. Indeed, Figures 1 and 2 disclose no such elements. Nothing in Figures 1 and 2 can be identified as an irregularly-shaped supination control portion, or an irregularly-shaped motion control portion. The Examiner also asserts that elements 12 and 20 of Mansfield '922 are the crescent-shaped arch stability portion described in claim 38. However, elements 12 and 20 are described in Mansfield '922, respectively, as "tear-dropped" and "rounded," not crescent-shaped. The Examiner's assertion is completely without merit. Thus, claim 38 is not anticipated by Mansfield '922.

Claim 39

Mansfield '922 does not disclose the supination control pad comprising an irregularly-shaped member having a variable wedge-shaped cross-section, with a thickness that decreases from the lateral edge to the medial edge and from a portion along the lateral edge to the anterior end and the posterior end, as described in claim 39. The Examiner simply asserts that these elements are disclosed in Mansfield '922, and references Figure 6. The Examiner does not attempt to identify those structural elements in Figure 6 corresponding to the supination control

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pad described in claim 39. Indeed, Figure 6 is completely devoid of any disclosure of the supination control pad or the supination control pad structural elements described in claim 39. The Examiner's assertion is completely without merit. Thus, claim 39 is not anticipated by Mansfield '922.

Claim 44

Mansfield '922 does not disclose the motion control pad comprising an irregularly-shaped elongated member having a variable wedge-shaped cross-section, with a thickness that decreases from the medial edge to the lateral edge and from a portion along the medial edge to the anterior end and the posterior end, as described in claim 44. The Examiner simply asserts that these elements are disclosed in Mansfield '922, and references column 7, lines 3-24. The Examiner does not attempt to identify those structural elements in column 7, lines 3-24 corresponding to the motion control pad structural elements described in claim 44. Indeed, column 7, lines 3-24 of Mansfield '922 is completely devoid of any disclosure of the motion control pad or the motion control pad structural elements described in claim 44. What is described in column 7, lines 3-24 are side walls and trim lines, not a motion control pad. The Examiner's assertion is completely without merit. Thus, claim 44 is not anticipated by Mansfield '922.

Claim 49

Mansfield '922 does not disclose the arch stability pad comprising a crescent-shaped member having a generally wedge-shaped cross-section, with a thickness that decreases from the central medial edge to the lateral edge, the anterior end, and the posterior end, as described in claim 49. The Examiner simply asserts that these elements are disclosed in Mansfield '922, and references Figure 6. The Examiner does not attempt to identify those structural elements in Figure 6 corresponding to the arch stability pad structural elements described in claim 49. Indeed, Figure 6 is completely devoid of any disclosure of the arch stability pad or the arch stability pad structural elements described in claim 49. Moreover, as discussed above, the

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portions of the Mansfield '922 stabilizer relating to arches are described as tear-dropped or rounded, not crescent-shaped. The Examiner's assertion is completely without merit. Thus, claim 49 is not anticipated by Mansfield '922.

Claim 54

Mansfield '922 does not disclose a resilient heel cushioning zone comprising a pattern of cutout sections immediately beneath a person's heel, as described in claim 54. The Examiner simply asserts that these elements are disclosed in Mansfield '922. However, the Examiner does not attempt to identify these elements in Mansfield '922, and Mansfield '922 is completely devoid of any disclosure of a pattern of cutout sections in a resilient heel cushioning zone. The Examiner's assertion is completely without merit. Claim 54 is not anticipated by Mansfield '922.

Claims 55, 56

Claims 55 and 56, respectively, describe a low density gel pad beneath a person's heel, and a low-density gel pad comprising a low-density gel polymer. Mansfield 922 does not disclose a gel pad beneath a person's heel, or a low-density gel pad comprising a low-density gel polymer. The Examiner simply asserts that these elements are disclosed in Mansfield '922, and references column 7, lines 47-61. The Examiner does not attempt to identify those structural elements in column 7, lines 47-61 corresponding to the gel pad described in claim 55 and the low-density gel polymer described in claim 56. Indeed, column 7, lines 47-61 of Mansfield '922 is completely devoid of any disclosure of a gel pad or a low-density gel polymer. What is described is a material "which is firm enough to retain its shape when weight is placed on the foot," and that the stabilizer can be made from polypropylene or polyethylene. Additionally, closed cell foam can be used as padding. None of these constitutes a low-density gel pad or a low-density gel polymer. Thus, claims 55 and 56 are not anticipated by Mansfield '922.

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CONCLUSION

For the reasons discussed above, all of the claims are in condition for allowance. Early notification of allowability is requested.

If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is invited to contact the undersigned.

Respectfully submitted,

ADRIANO ROSA

Dated: 2/25/05

By: 

Michael F. Kelly, Reg. No 50,859

John E. McGarry Reg. No. 22,360

McGARRY BAIR PC

171 Monroe Avenue, NW, Suite 600

Grand Rapids, Michigan 49503

616-742-3500

G0158404